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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,821	01/24/2001	Maximilian Angel	51162	2188

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EXAMINER	
WELLS, LAUREN Q	

ART UNIT	PAPER NUMBER
1617	15

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/767,821	Applicant(s) ANGEL ET AL.	
	Examiner Lauren Q Wells	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 August 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,7 and 10-17* is/are pending in the application.

4a) Of the above claim(s) *7 and 11-17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claims 1-3, 7 and 10-17 are pending. Claims 7 and 11-17 are withdrawn from consideration by original presentation. The Amendment filed 8/28/03, Paper No. 14, cancelled claims 6, 8 and 9, amended claims 1, 7 and 11, and added claims 12-17.

Election/Restrictions

Newly submitted claims 12-17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 1-3, and 10 are directed to a method of making a polymer and claims 12-17 are directed to compositions comprising additional ingredients and polymers made by claim 1. These inventions are distinct, as they are related by way of an intermediate-final product relationship. In the instant case, the intermediate product, the polymer can be useful as a protective colloid for dispersion polymerization or as a chewing gum. Thus, these inventions are distinct and a serious burden would be placed on the Examiner to examine such claims.

Applicant argues that these claims are related as combination/subcombination. However, this argument is not persuasive. See above for how claims are related by way of intermediate and final product.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 12-17 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant's election with traverse of the Restriction Requirement between Groups I and III in Paper No. 12 is acknowledged. The traversal is on the ground(s) that it is not apparent how

such starting materials could possibly be materially different from applicants' product which is defined in terms of a product by process and which recite the same limitations which characterize applicants' process. This is not found persuasive. As stated in the previous Office Action, the process of Group I can be used to make the starting materials of foamed substances, such as sponges. And in regard to Group III, which are product by process claims, it is respectfully pointed out that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

The requirement is still deemed proper and is therefore made FINAL.

Response to Applicant's Arguments/Amendment

The Applicant's arguments filed 8/28/03 (Paper No. 14) to the rejection of claims 1, 3 and 10 made by the Examiner under 35 USC 103 have been fully considered and deemed not persuasive.

The Applicant's amendment to the claims filed 8/28/03 (Paper No. 14) is sufficient to overcome the 35 USC 112 rejections in the previous Office Action.

103 Rejection Maintained

The rejection of claims 1, 3 and 10 under 35 U.S.C. 103(a) as being unpatentable over GB 922,459 in view of Wu et al. (5,338,814) is MAINTAINED for the reasons set forth in the Office Action mailed 4/9/03, Paper No. 12, and those found below.

Applicant argues, "GB 922,459 fails to suggest or imply the utilization of a polyether corresponding to applicants' constituent (b)". This argument is not persuasive. Page 8 of '459 teaches a process for the manufacture of graft copolymers, which comprises dissolving a polyalkylene oxide (constituent (b)) or a polyalkylene glycol (constituent (b)) in a vinyl ester, acrylic acid ester or methacrylic acid ester monomer. . .and polymerizing the monomer or monomers in the presence of a free radical polymerization catalyst, wherein polyethylene glycol is specifically exemplified as the preferred polyalkylene. Additionally, on page 4, oxyethylenated polypropylene glycol (constituent (b)) is taught as being incorporated into the reaction mixture. Applicant argues, "GB 922,459 fails to suggest or imply to add the initiator to the polymerizable composition in the form of a solution, and fails to suggest or imply the utilization of a liquid polyethylene glycol having a molecular weight of from 88 to 1000 as the solvent for the free radical initiator". This argument is not persuasive, as Applicant is arguing against the references individually, when the rejection was made in combination. Additionally, the Examiner respectfully points out that all of the examples of GB '459 exemplify a solution comprising vinyl ester, formula I, and free radical initiator.

Applicant argues, "the disclosure of Wu et al. is concerned with the preparation of a homopolymer rather than a graft copolymer". This argument is not persuasive. Wu et al. and GB '459 are both directed to a method of making polymers from monomeric units. Thus, both references are in the same field of endeavor.

Applicant argues, "In light of the differences between the preparation of graft copolymers on the one hand and (non-grafted) PVP homopolymers on the other hand, a person of ordinary skill would not have an inventive to modify the graft copolymerization taught by GB 922,459 by

introducing parameters which are applied in the homopolymerization process of Wu et al.". This argument is not persuasive. As pointed out above, Wu et al. and GB '459 are both directed to a method of making polymers from monomeric units. Thus, both references are in the same field of endeavor. Additionally, both Wu et al. and GB '459 are directed to methods of polymerization utilizing free radical solution polymerization. Wu et al. teach the advantages of polymerization in the presence of a solution of polyethylene glycol having a MW of about 300, i.e., control of MW of the polymer and not hindering the termination process by viscosity buildup. Thus, there is motivation to combine the two references.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw

SREENI PADMANABHAN
PRIMARY EXAMINER

9/22/03